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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91160266
Party	Defendant CREATIVE ARTS BY CALLOWAY, LLC CREATIVE ARTS BY CALLOWAY, LLC 405 REGENCY CT HOCKESSIN, DE 19707
Correspondence Address	CYNTHIA JOHNSON WALDEN FISH & RICHARDSON P.C. 225 FRANKLIN STREET BOSTON, MA 02110-2804 UNITED STATES
Submission	Opposition/Response to Motion
Filer's Name	Kristen McCallion
Filer's e-mail	mccallion@fr.com, fletcher@fr.com, tmdocny@fr.com, walden@fr.com, mvanderson@fr.com
Signature	/kxm/
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Attachments	Call Opp.pdf (8 pages)(306693 bytes)

Attorney's Docket No.: 18998-002PP1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 75761159
For the Mark CAB CALLOWAY

CHRISTOPHER BROOKS,	:	
Opposer,	:	
v.	:	Opposition No. 91160266
CREATIVE ARTS BY CALLOWAY, LLC,	:	
Applicant.	:	

APPLICANT'S OPPOSITION TO OPPOSER'S JANUARY 19, 2007 MOTION FOR RECONSIDERATION OF THE BOARD'S DECEMBER 21, 2006 DECISION OF OPPOSER'S DECEMBER 22, 2005 MOTION FOR RECONSIDERATION OF THE BOARD'S NOVEMBER 23, 2005 DENIAL OF OPPOSER'S DECEMBER 30, 2004 MOTION FOR SUMMARY JUDGMENT

Statement

Opposer commenced this proceeding April 13, 2004. On December 30, 2004, after discovery had closed and two weeks before his testimony period was scheduled to open, Mr. Brooks moved for summary judgment, submitting, *inter alia,* a statement of 41 purportedly undisputed material facts, 25 of which are conceded to be undisputed. The other 16 are either disputed, some vigorously, or insufficiently documented (or, perhaps, articulated) to permit Applicant to either accept or dispute.

On November 23, 2005, summary judgment was denied because there are disputed issues of fact. Less than a month before his testimony period was scheduled to open, Mr. Brooks sought reconsideration for the denial of summary judgment.

On December 21, 2006, reconsideration was granted, but summary judgment denied because there are disputed issues of fact. On January 19, 2007, less than a week before his testimony period was scheduled to open, Mr. Brooks again sought rehearing. A pattern is becoming apparent.

Rather than face the test of trial of numerous disputed facts, and resolution of those disputes on the basis of evidence, Opposer seeks (for the third time) to steal judgment on motion. His chosen tactic is to nit-pick some particular of the previous Board decision as an excuse to once again attempt to evade a Board sorting of the evidence supporting (or not) the much-disputed factual foundations of his case.

Less than two months ago, the Board ruled that "this proceeding is not amenable to summary judgment because genuine issues of material fact remain with respect to the issue of priority." The Board then gave one example of such an issue, stating it was "sufficient to raise a genuine issue of material fact concerning priority." December 21 decision, p. 3. The Board did not state that the Cab Calloway School of Arts use is the only disputed issue as to priority, and it isn't. As before, however, Opposer nit-picks the Board's example, ignoring the fact that many, many of the facts it submitted as "material" remain in dispute.

THE PRIMARY DISPUTE AS TO PRIORITY

Without further proof, Applicant's priority date for purposes of the present opposition is July 23, 1999, which is the filing date of its application that is opposed. See Section 7(c) of the

Trademark Act, 15 U.S.C. § 1057(c). "The only date on which Applicant can rely for purposes of priority is the filing date of July 23, 1999." Notice of Opposition ¶ 5. Section 7(c) requires Mr. Brooks, if he is to prevail, to demonstrate that prior to July 23, 1999 he "has used the mark." The meaning of this statutory requirement is critical: "A party who alleges a use prior to an opponent's constructive use date must prove its priority under the traditional rules of common law trademark priority." 2 McCarthy on Trademarks § 16:17 (4th ed. Rel. 34, 6/2005). What Opposer seeks to protect is CAB CALLOWAY, a personal name. As the foremost authority on common law trademarks states,

> A designation that is likely to be perceived by prospective purchasers as... the personal name of a person connected with the goods, services or business, is not distinctive.... Such a designation is distinctive only if it has acquired secondary meaning. . . .

Restatement Third, Unfair Competition § 14.

> *e. Personal names.* Personal names, including both first names and surnames, are not considered to be inherently distinctive and are therefore protectable as trademarks or trade names only upon proof of secondary meaning. Thus, the first person who adopts a particular personal name to identify the person's goods, services or business obtains no rights in the designation unless consumers have in fact come to recognize the name as a symbol that distinguishes the products or business of that person from those of others.

Id., Comment e.

Thus, to prevail, Opposer Brooks must establish that prior to July 23, 1999, CAB CALLOWAY had come in the public mind to identify his services.[1] Mr. Brooks thus far has

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[1] Similarly, see: "Personal names are placed by the common law into that category of inherently non-distinctive terms which require proof of secondary meaning for protection. Under the traditional rule, personal names are regarded as in the same category as descriptive terms. This means that they can be protected as trademarks only upon proof that through usage they have acquired distinctiveness and secondary meaning.

* * * * *

"Personal names for which secondary meaning is normally required include surnames alone, the combination of a first name and surname, and a first name alone...." 2 McCarthy's of Trademarks §13:2 (4th ed. Rel. 38, 6/2006), footnotes omitted.

neither recognized, nor attempted to shoulder, his burden to prove that as of July 23, 1999 the primary meaning of CAB CALLOWAY to the purchasing public was his services.[2] Proof of this critical, legally required, fact has not been attempted by Mr. Brooks, so it can hardly be said to be undisputed. It will be disputed – vigorously -- if undertaken.

THE CAB CALLOWAY SCHOOL

In a declaration executed June 24, 2005 and filed in opposition to Mr. Brooks' summary judgment motion, Ms. Cabella Calloway Langsam, Cab Calloway's daughter, stated:

> 9. In recognition of Cab Calloway's involvement with the school and to honor his status as an international jazz icon, the Red Clay School District sough Cab Calloway's permission to name the school "Cab Calloway School of the Arts." Cab Calloway authorized the school to use his name as the name of the school.
>
> * * *
>
> 11. Since at least 1994, the Cab Calloway School of the Arts has used CAB CALLOWAY as a service mark in connection with the production and presentation of theatrical plays and musical performances. Cab Calloway School of the Arts regularly performs musical concerts and theatrical plays both at the school and in a variety of public venues. . . .
>
> 12. Cab Calloway and his successors in interest also authorized the Cab Calloway School of Arts to sell various clothing items, school supplies, and other products bearing the CAB CALLOWAY mark. Cab Calloway School of the Arts currently sells clothing items and has done so since at least as early as 1994 pursuant to its license from Cab Calloway and his Estate to do so. See Exhibit 7.

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[2] Given that the name identifies "the great Cab Calloway, the world-renowned jazz musician, singer, composer and entertainer," who "was known for songs such as 'Minnie the Moocher,' appearances in musicals such as *Porgy and Bass,* and regular performances at The Cotton Club [where he] performed solo, with a small ensemble under the name 'Cab Calloway and the Cab Jivers,' and with big bands under the name 'Cab Calloway and the Hi De Ho Orchestra,' 'Cab Calloway and His Famous Orchestra," and 'Cab Calloway and the Cotton Club Orchestra" (Notice of Opposition, Exhibit A, p. 2), the undertaking is formidable, and seems hopeless. But Mr. Brooks is entitled to attempt that factual showing if he wishes.

Thus far, Mr. Brooks factual record has concentrated on the cumulative quantum of his use either shortly before December, 2001 (See Not. Opp. ¶ 2) and/or April 13, 2004 (*Id.*, ¶ 8). Both are long after the Applicant's priority date of July 23, 1999.

The declarant was President of the Board of Directors of the Cab Calloway School of the Arts from 1992 to 1994, and has since remained an honorary member of the Board. *Id.*, ¶ 13. These are factual declarations of record in this proceeding.

To be sure, these facts are disputed by Mr. Brooks. Indeed, six of the present motion for reconsideration's ten pages are devoted to disputing these facts (which of course does not make them "undisputed" in any normal sense of the word). It is even theoretically possible that Mr. Brooks and his attorneys will eventually prevail on these disputed factual questions. That is neither the point nor the question at this time. The point, which Mr. Brooks' motion for reconsideration hammers home so emphatically, is that this is a disputed issue of fact to be resolved.

Summary judgment at this stage is inappropriate.

CONCLUSION

This Request for reconsideration is brought pursuant to 37 C.F.R. § 2.127(b). That section does not "contemplate a second request for reconsideration of the same basic issue." TMBP § 518. The "basic issue" upon which the original motion for summary judgment was denied was that there are factual issues in dispute. The same "basic issue" was the ground for denial of the first motion for consideration. It is the ground upon which this new motion for reconsideration also must be denied.

Mr. Brooks (or his counsel) will no doubt take the position that since they pinpointed a different allegedly "undisputed" issue with each motion for rehearing, there is nothing wrong with this motion. The problems with that argument are: (i) it is now more than two years since their original motion for summary judgment was filed; (ii) at the least, one may expect months more of delay to proceed to "trial"; and (iii) in an action as replete with disputed facts as this one,

Mr. Brooks can easily delay matters several more years if he is allowed repeatedly to move for reconsideration on other supposedly undisputed facts. Such delay would be unconscionable.

These applications were filed in 1999, and opposed in 2004. The value of the marks sought to be registered has eroded as a result of the unilateral attempt by Mr. Brooks to appropriate the CAB CALLOWAY mark. If Mr. Brooks can show good grounds for his claim of priority to the CAB CALLOWAY mark, he should be required to show them. That, after all, is presumably why he filed his opposition in the first place. He should not be permitted to further fritter away the value of Applicant's applied-for mark with frivolous motions for reconsideration (or by Petition to the Commissioner, an alternative delaying tactic). The ultimate outcome of this proceeding is apparent, and it has already been delayed far too long.

Accordingly, Applicant Creative Arts by Calloway, LLC respectfully requests that the Board:

(1) Expeditiously deny Opposer's present Motion for Reconsideration;

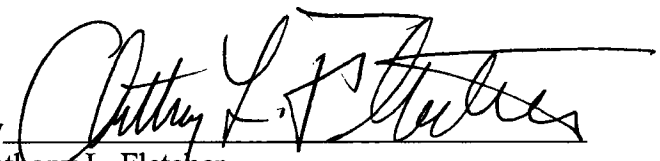
(2) Set early trial dates; and

(3) Advise Opposer that any further Request for Reconsideration or Petition to the Commissioner will, if denied, result in Judgment for Applicant.

Respectfully submitted,

FISH & RICHARDSON P.C.

Dated: February 7, 2007

By 

Anthony L. Fletcher
Citigroup Center
153 East 53rd Street, 52nd Floor
New York, NY 10022-4611
Telephone: (212) 765-5070
Facsimile: (212) 258-2291

Cynthia Johnson Walden
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Joel D. Leviton
60 South Sixth Street
3300 Dain Rauscher Plaza
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile (612) 288-9696

Attorneys for Applicant,
CREATIVE ARTS BY CALLOWAY, LLC

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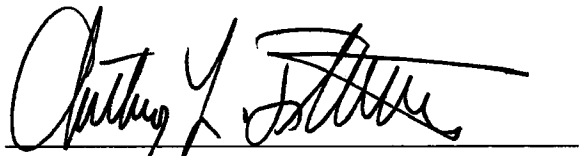
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **APPLICANT'S OPPOSITION TO OPPOSER'S JANUARY 19, 2007 MOTION FOR RECONSIDERATION OF THE BOARD'S DECEMBER 21, 2006 DECISION OF OPPOSER'S DECEMBER 22, 2005 MOTION FOR RECONSIDERATION OF THE BOARD'S NOVEMBER 23, 2005 DENIAL OF OPPOSER'S DECEMBER 30, 2004 MOTION FOR SUMMARY JUDGMENT** has this 7th day of February 2007, been mailed by prepaid first class mail to the below-identified Attorney at his/her place of business:

Barbara A. Solomon, Esq.
Evan Gourvitz, Esq.
FROSS ZELNICK LEHRMAN & ZISSU, P.C.
866 United Nations Plaza
New York, NY 10017



Anthony L. Fletcher